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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,189	11/21/2000	Bernard H. Wolzenski	GNA 1804.1	9504

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SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,189

Applicant(s)

WOLZENSKI ET AL.

Examiner

Clement B Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-24 remained pending and claims 25-34 has been added.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-24, are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. The claimed invention is noted not to be a computer program, data structure, a natural phenomenon, and a non-descriptive material per se. Furthermore, the claimed invention do not produce a useful, concrete and tangible result therefore they are nonstatutory. The claimed invention also is not a product for performing a process, nor it is a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction.

As to the technology requirement, note MPEP Section iV 2(b). Also note In Re Waldbaum, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In re Musgrave, 167USPQ 280 (CCPA1970), In re Johnston, 183USPQ 172 (CCPA 1974), and In re Toma, 197USPQ 852 (CCPA 1978), all teach a technological requirements.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

- 1) In the claim, the practical application of an algorithm or idea result in a useful, concrete, tangible result, AND
- 2) The claim provides a limitation in the technological art that enables a useful, concrete, tangible result.

Applicant's is advised to embed a "computer" in the body of the claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-19, are rejected under 35 U.S.C. 102(e) as being anticipated by Moran U.S. Patent No. 6, 430, 542).

As per claim 1, Moran discloses a computerized process for generating a financial and liquidity estate plan for a client ("i. e, member") said process comprising the steps of;

determining assets of the client.(see column 42 lines 10-40) defining a plurality of asset categories based on type and purpose of asset categorizing the client's assets in the defined categories.(Note abstract and see 17 lines 5-65 and column 18 lines 35-60) and performing liquidity analyses of the categorized assets to determine current estate liquidity and projected future estate liquidity of the client (see column 26 lines 23-65 and column 27 lines 1-9) and generating a plan for re-allocating the client's assets among the defined categories based on the liquidity analyses. (see column 46 lines 10-23).

As per claim 2, Moran discloses wherein the step of defining the categories includes defining a first category for assets that are generally non-liquid and intended for personal enjoyment of the client.(see column 24 lines 6-8 an column 42 lines 10-42).

As per claim 3, Moran discloses wherein the step of defining the categories includes defining a second category for cash and cash-equivalent assets that are generally intended for reserve capital purposes. (see column 42 lines 10-40).

As per claims 4, Moran discloses wherein the step of defining the categories includes defining a third category for unprotected assets that are generally growth oriented anal intended for funding retirement of the client. (see column 42 lines 10-40).

As per claims 5, Moran discloses wherein the step of defining the categories includes defining a fourth category for protected assets that are generally exempt from

creditors and intended for providing retirement protection and estate liquidity. (see column 42 lines 10-40).

As per claim 6, Moran discloses further comprising the step of defining a life insurance product.(see column 42 lines 10-40) said product being a protected asset having a pre-paid death benefit purchased with a single premium and providing a series of additional pre-paid death benefits each purchased with a single premium as scheduled for future purchase.(Note abstract and see 17 lines 5-65 and column 18 lines 35-60 and column 19 lines 1-10).

As per claim 7, Moran discloses wherein the defined life insurance product a pre-paid, variable life insurance product. (Note abstract and see 17 lines 5-65 and column 18 lines 35-60).

As per claim 8, Moran discloses wherein the step of defining the life insurance product includes maximizing cash value of the product per premium dollar by removing up-front loads and reducing ongoing charges. (see column 42 lines 5-42).

As per claim 9, Moran discloses wherein the step of defining the life insurance product includes minimizing "at risk mortality" casts by cash value purchasing a minimum desired amount of life insurance. (see column 20 lines 20-43).

As per claims 10 wherein the plan for re-allocating the clients assets includes consuming unprotected assets before protected assets. (see column 46 lines 10-23).

As per claim 11, Moran discloses wherein the plan for re-allocating the clients assets further includes consuming the defined life insurance product after other protected assets. (see column 46 lines 10-23).

As per claim 12, Moran discloses wherein the step of performing the liquidity analyses includes determining asset protection needs of the client. (see column 42 lines 10-40).

As per claim 13, Moran discloses wherein the step of performing the liquidity analyses includes executing a plurality of modules for analyzing the categorized assets. (Note abstract and see 17 lines 5-65 and column 18 lines 35-60).

As per claim 14, Moran discloses wherein the liquidity analyses modules include a current liquidity module, said current liquidity module comprising the steps of analyzing

the categorized assets and determining the current liquidity of the client's assets. (see column 42 lines 10-40).

As per claim 15, Moran discloses wherein the liquidity analyses modules include a retirement protection module, said retirement protection module comprising the steps of defining retirement goals of the client, calculating the amount of assets needed in each of the defined categories to meet the defined retirement goals, analyzing the categorized assets and determining whether the client's assets meet the defined retirement goals. (see column 16 lines 25-45 and column 42 lines 5-42).

As per claim 16, Moran discloses wherein the retirement protection module further comprises the step of calculating an amount of non-exempt assets to convert to exempt assets based on a projected rate of consumption of assets relative to the client's retirement goals. (see column 16 lines 25-45 and column 42 lines 5-42).

As per claim 17, Moran discloses wherein the retirement protection modules further comprises the step of calculating a systematic asset allocation schedule for converting the non-exempt assets to exempt assets. (see column 46 lines 10-23).

As per claim 18, Moran discloses wherein the liquidity analyses modules include estate tax liquidity and estate tax reduction modules, said estate tax liquidity and reduction modules comprising the steps of defining estate protection goals of the client, calculating the amount of assets needed in each of the defined categories to meet the defined estate protection goals, analyzing the categorized assets and determining whether the client's assets meet the defined estate protection goals. (see column 16 lines 25-45 and column 42 lines 5-42).

As per claim 19, Moran discloses wherein the steps of categorizing the client's assets, performing the liquidity analyses and generating the plan for re-allocating the client's assets are executed on a computer. (see column 39 lines 34-41).

6. Claims 20-25, are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan et al. (Hereinafter Ryan U.S. Patent No. 5, 802, 500).

As per claims 20-25 Ryan discloses a computerized process for defining a pre-paid, variable life insurance product comprising the steps of defining a premium; determining a cash value of the product based on the premium

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defining a pre-paid death benefit purchased with the premium based on the cash value of the product (see column 4 lines 5-65 and column 6-10 lines 5-65)

investing the cash value of the product in one or more investment accounts;

adjusting the cash value of the product as a function of gains and losses on the investment accounts and defining the pre-paid death benefit purchased with the premium based on the adjusted cash value of the product.(see column 3 lines 19-56 and column 4 lines 5-65 and column 6-10 lines 5-65).

7. Claims 26-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran U.S. Patent No. 6, 430, 542) Ryan et al in view of view of (Hereinafter Ryan U.S. Patent No. 5, 802, 500).

Claims 26-34 Moran discloses a computer-readable medium having computer-executable modules comprising:

a current liquidity module for performing a liquidity analysis to determine a current value of assets of a client if liquidated at present, each of said assets being categorized in one of a plurality of asset categories based on type and purpose of the assets, said liquidity analysis being a function of the asset categories.(Note abstract and see 17 lines 5-65 and column 18 lines 35-60) a projected liquidity module for performing the liquidity analysis to determine a projected value of the assets of the client if liquidated at a projected retirement age of the client a retirement protection module for generating a plan to re-allocate the assets of the client among the asset categories based on the liquidity analyses to provide protection of retirement landing for the client (see column 26 lines 23-65 and column 27 lines 1-9) said plan including re-allocating at least a portion of the assets(see column 42 lines 10-40 and abstract and see 17 lines 5-65 and column 18 lines 35-60 and (see column 46 lines 10-23) and variable life insurance product at relatively lower risk. (see column 42 lines 10-40 and abstract and see 17 lines 5-65 and column 18 lines 35-60 and (see column 46 lines 10-23).

Moran Fail to explicitly teach prepaid.

However Ryan discloses a computer and a data processing system, and methods involving the same, applied to the financial fields of insurance and benefit funding. More particularly, this invention relates to a computer system for analyzing and projecting the

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after-tax cash flow and the balance sheet and income statement consequences of a pre-funding program for Other Postretirement Employee Benefits (OPEBs).(see column 3-4 line 5-65).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include prepaid taught by Ryan in order to pre-fund benefits.

Conclusion

Response to Arguments

8. Applicant's arguments filed on 07/13/2004 have been fully considered but are they are moot in view of new grounds of rejections.

9. The Examiner apologist for indicating that Moran fail to teach some features when it did teach these features upon reexamination, however it is also the Applicant's responsibility to read the prior art of reference in its entirety.

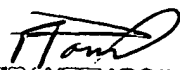
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

December 21, 2004


FRANTZY POINVIL
PRIMARY EXAMINER
AU 3628